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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,967	05/08/2001	Stuart A. Newman	51230-00601	1338

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EXAMINER

YU, MISOOK

ART UNIT PAPER NUMBER

1642

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/849,967

Applicant(s)

NEWMAN ET AL.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 21, 29, 30 and 55-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 57-64 is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15, 21, 29 and 58 is/are rejected.
- 7) ☒ Claim(s) 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/2005 has been entered.

Claims 1, 29, 57, 59, 61, and 63 are amended. Claims 1-6, 9-15, 21, 29-30, and 55-64 are pending and examined on merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

Claim 55 is newly objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The specification at Examples 1 at page 59, FGFR2 exon 8 has ESS. However, claim 55 is drawn more than ESS.

### ***Claim Rejections - 35 USC § 112, Withdrawn***

The rejection of claims 1-15, 21, 29, 30, and 55-64 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is **withdrawn** because applicant argument is persuasive.

The rejection of claims 1-15, 21, 29, 30, 55, and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment.

***Claim Rejections - 35 USC § 102***

Claims 57, 58, 61-64 **remain rejected** under 35 U.S.C. 102(b) as being anticipated by Purcell and Martin (J. Virol., 1993, vol. 67, pages 6365-78) as evidenced by Damgaard et al., (2002, RNA, vol. 8, pages 1401-1415) and by Section 2. Virology (total 5 pages) of Medical Microbiology (S. Baron, ed) downloaded from [url>>cbi.nlm.nih.gov/books](http://cbi.nlm.nih.gov/books) on 4/20/2004.

Claims 57, 58, 61-64 are interpreted as drawn to method with only one manipulative active step i.e. introducing into a cell a plurality of RNA polynucleotide sequences consisting essentially of at least one intronic splicing (ISS) in claims 57, and 58, exonic splicing silencer (ESS) in claims 61, and 62, exonic splicing enhancer (ESE) in claims 63 and 64, wherein the introduced polynucleotide sequences compete with at least one endogenous RNA sequence for interacting with the hnRNP A protein or hnRNP A1 protein or hnRNP A protein.

Applicant argues that the product used in the amended claims with the transitional phrase "consisting essentially of" is different from the HIV genome of Purcell and Marin used in the study of infecting HIV-1 virus to lymphocytes or human T-cell lines by contacting the cell lines with HIV-1 virus. This argument has been fully

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considered but found unpersuasive/ The amended claims 56, 57, 58, 61-64 as currently construed still read on the procedure of infecting HIV-1 virus to lymphocytes or human T-cell lines by contacting said cell lines with HIV-1 virus disclosed in lines 4-5 of abstract, and page 6366, right column, under the heading "Cell culture, transfections, and infections", page 6374 under the heading "Infectivity of splicing mutants of HIV-1" of Purcell and Martin (cited above) because the transitional phrase "consisting essentially of" is interpreted as open (i.e. same scope as "comprising") unless the specification as originally filed defines the scope to be otherwise. As stated before in the previous Office action, HIV-1 RNA inherently has ESS, and other sequences (as evidenced by Damgaard et al., note abstract, page 1403, Table 1) that hnRNP A1 (species of hnRNP A) binds to. In summary, the product used in the amended base claims still read on the HIV-1 genome, which comprises ESS, ISS, and ESE.

Rejection of all other claims not repeated here is withdrawn because the amended claims are no longer anticipated by the art if record.

***Allowable Subject Matter***

Claims 1-6, 9-15, 21, 29, 30, and 56 are allowed.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MISOOK YU, Ph.D.  
Examiner  
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